

## REMARKS

The amendments to the claims in the Amendment filed November 13, 2006, were not entered as per the Advisory Action of December 8, 2006. Thus, these amendments are being re-submitted in this Preliminary Amendment.

The amendments of claims 1 and 16 are fully supported by Figure 1 and the description of Figure 1 in paragraph [0008] of the specification.

Claims objections with respect to claims 19, 20 and 23 should be withdrawn in light of this Amendment.

Claims 1-10, 16-17 and 19-23 were rejected as being obvious over MacLeod in view of FR '643. This rejection is respectively traversed.

Claim 1 is directed to a *system* for radially positioning a workpiece for electrochemical machining, the system comprising: *a base having a cavity to hold the workpiece, the cavity having an electrode contact therein*, a pressurized air chamber configured to contain pressurized air; and an expandable diaphragm configured to position the workpiece radially relative to an electrode assembly in response to the pressurized air being released into the pressurized air chamber, wherein the workpiece is positioned by the system to permit electrochemical machining of the electrode assembly.

Claim 16 is directed to a *system* for radially positioning a workpiece for electrochemical machining, the system comprising: *a base having a cavity to hold the workpiece, the cavity having an electrode contact therein*, a pressurized air chamber for deflecting a thin wall of an expandable diaphragm, the deflection causing the workpiece to position radially relative to an electrode assembly, wherein the workpiece is positioned by the system to permit electrochemical machining of the electrode assembly.

MacLeod teaches nothing about such a system having *a base having a cavity to hold the workpiece, the cavity having an electrode contact therein*, a pressurized air chamber and an

expandable diaphragm configured to position the workpiece radially. MacLeod discloses a workpiece for electrochemical machining and an electrode assembly, but *not* a system as claimed. In particular, MacLeod fails to disclose *a base having a cavity to hold the workpiece, the cavity having an electrode contact therein*, as recited in claims 1 and 16.

Recognizing these deficiencies in MacLeod, the Examiner relies on FR '643 to fill the gaps in MacLeod. However, FR '643 also fails to disclose a system wherein one of the component is *a base having a cavity to hold the workpiece, the cavity having an electrode contact therein*, as recited in claims 1 and 16. Thus, the cited references do not *as a whole* disclose this limitation.

In rejecting claim 22, the Examiner states that “the elastic material of the elastic hollow toric (i.e. pressurized air chamber with expandable diaphragm) as taught by MacLeod in view of FR '643 forms a hydraulic seal between the elastic hollow ring and the workpiece about the entire outer circumference of the workpiece as claimed.” The Examiner has acknowledged on page 3 of the Action that “MacLeod does not explicitly teach the claimed pressurized air chamber.” In light of this statement, it appears that the Examiner’s statement regarding “pressurized air chamber with expandable diaphragm … as taught by MacLeod” appears to be inconsistent.

The Examiner has also cited MPEP 2115 for teaching that the inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. However, MPEP 2115 also clearly states, “Note that this line of cases is limited to claims directed to machinery which works upon an article or material in its intended use. It does not apply to product claims or kit claims (i.e., claims directed to a plurality of articles grouped together as a kit).” Claims 1 and 16 are *system* claims (like a kit claim) directed to a plurality of articles groups together. Thus, the cases cited by the Examiner do *not* apply to the system claimed in this application.

In light of the above, a Notice of Allowance is respectfully solicited.

In the event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing attorney docket no. **146712017800**.

Dated: December 21, 2006

Respectfully submitted,



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